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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,455	09/28/2001	Kristin Carman	06975-156001/Packaging 02	1706
26171	7590	07/13/2005	EXAMINER	
FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			ACKUN, JACOB K	
			ART UNIT	PAPER NUMBER
			3723	

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/964,455

Applicant(s)

CARMAN ET AL.

Examiner

Jacob K. Ackun Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6,7,10-29,32-34 and 36-53 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 6,7,10-29,32-34 and 36-53 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 6, 7, 10-29, 32-34, 36-50 and 51-53 are finally rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Gelardi (5,799,782) in view of Hansen (5,713,462), Warfield (5,611,426), or Koehn (6,068,117). Gelardi appears to show all of the limitations of the claims, including the new limitations now added to the independent claims. In the Fig 14 embodiment, for example, the transparent cover 5 meets the requirements of the claimed window because it is smaller than either of the sides to which it is attached. For example, the entire side 3 including rib 39 (even when transparent) is slightly larger than the cover. Note also that the transparent cover does not wrap around the sidewalls of side 3. In another interpretation of the reference the claimed window is formed by only the portions of the transparent cover that are not obstructed by the ledges or tabs 19 protruding inwardly from the walls of the sides such as side 3. Such portions of the cover being even smaller than the entire cover also meet the requirement in the claims of being smaller than a side.

The claimed spokes are the portions between corner openings 15 one of which extends

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towards the opposite side as claimed in claims 6 and 28 (see Fig 14), or the individual arms of the disk retainer or rosette 13, one of which also extends as recited in claims 6 and 28.

However, should the window in Gelardi be later deemed not to meet the size requirements of the claims, each of the secondary references is applied to show that it is conventional to construct the wall of a compact disc container to have a window smaller than the wall. Accordingly it would have been obvious in view of either secondary reference to construct the case of Gelardi to have the cover only be transparent in a limited area (such as with use of the disclosed paperboard ((see Gelardi at column 3 line 1)) incorporating therein a transparent window, also as in the secondary references), for the purpose of providing a more economical construction, or facilitating the viewing of only limited portions of the interior of the case.

Other features of the claims not specifically disclosed in Gelardi would also have been obvious thereover for the purpose of constructing a package more suitable for particular disks or advertising. The method claims recite obvious steps of using or constructing the container of Gelardi modified as set forth above.

4. Claims 6, 7, 10-29, 32-34, 36-50 and 51-53 are finally rejected under 35 U.S.C. 103(a) as anticipated by Roth et al (5,284,242), or as obvious over Roth et al in view of Gelardi et al (5,284,243). Roth discloses all of the elements of the claims including window 68, or where only the frame is considered to meet the claimed holder, opening 24. The spokes as claimed read on the individual arms of the spindle or rosette 34.

However, should Roth be deemed not to show features such as a spoke 32 extending as claimed Gelardi is cited to show that it is conventional to have spokes of the type shown at 32 in Roth extending towards an opposite side as required in the claims. It would have been obvious in

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view of Gelardi to construct additional spokes 32 as in Roth as claimed, for the purpose of providing a stronger package. The method claims recite obvious steps of using or constructing the container of Roth modified as set forth above.

5. The prior double patenting rejection remains effective but is not reproduced herein in view of applicants expressed intention to file a terminal disclaimer in this case to obviate the rejection.

6. Applicant's arguments with respect to the claims at bar have been considered but are moot in view of the new ground(s) of rejection. The amendments to the claims and the accompanying arguments are noted. However, the claims remain overly broad as indicated by the new rejections.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

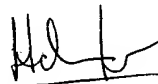
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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob K. Ackun Jr. whose telephone number is (571)272-4418.

The examiner can normally be reached on Monday through Friday 8.30AM-5.00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on (571)272-4485. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jacob K. Ackun Jr.
Primary Examiner
Art Unit 3723

J.A.